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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/570,618

03/03/2006

Keiji Otaki

127231

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EXAMINER

PIZIALI, ANDREW T

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/570,618	<b>Applicant(s)</b> OTAKI ET AL.	
	<b>Examiner</b> Andrew T. Piziali	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/3/06 &amp; 4/3/06</u>                                       | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-5 and 7-11, in the reply filed on 12/3/2007, is acknowledged. The traversal is on the grounds that the examiner failed to establish that the subject matter of the independent claim does not define a contribution over the prior art. This is not found persuasive because the examiner previously stated that the "X" and "Y" references on the International Search Report demonstrate that the independent claim of the application does not avoid the prior art. It is noted that the applicant failed to show, or attempt to show, that the "X" and "Y" references on the International Search Report do not teach or suggest the subject matter of the independent claim. In addition, the below rejections demonstrate that the claims fail to provide a contribution over the prior art. Claim 6 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper and is therefore made FINAL.

### ***Information Disclosure Statement***

2. The information disclosure statement filed 3/3/2006 cites JP 6-38674 and the applicant included an English language computer translation copy of the document titled 'PRODUCTION OF SMOKED SALMON' but it does not include a concise explanation of the relevance. The applicant is requested to explain the significance of the reference.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4, 7, 8 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The word "type" extends the scope of an expression so as to render it indefinite. See MPEP 2173.05(b).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,381,330 to Gotomyo in view of any one of USPN 5,665,447 to Greaves or JP 07-096563 to Hoshino.

Gotomyo discloses a glass wool product comprising a layered body of glass wools, characterized in that the layered body does not contain any binder, the layered body is needle punched in a direction orthogonal to a longitudinal direction of the wools thereof, so that the layered body is integrally formed, the wools have a length between 3 to 150 mm (see entire document including column 2, lines 5-58).

Gotomyo is silent with regards to specific glass wool diameter, therefore, it would have been necessary and thus obvious to look to the prior art for conventional glass wool diameters. Greaves and Hoshino each provide this conventional teaching showing that it is known in the glass wool art to use glass wools with a diameter of 3 to 25 microns (see entire documents including column 4, lines 43-46 of Greaves and computer translation Detailed Description paragraph [0016] of Hoshino). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the glass wools with an average diameter of 3 to 7 microns, motivated by the expectation of successfully practicing the invention of Gotomyo.

Regarding claim 2, Gotomyo discloses that the molded product has a multilayer structure in the direction orthogonal to the longitudinal direction of the wools (Figures 1 and 2), and that the average diameter of the wools of a first layer and that of the wools of a second layer differ from each other (column 2, lines 26-30 discloses that the fibers shrink).

Regarding claim 3, Gotomyo discloses that the molded product has a multilayer structure in the direction orthogonal to the longitudinal direction of the wools (Figures 1 and 2), and that the density of the first layer and that of the second layer differ from each other (column 2, lines 30-32 discloses that the fibers are more condensed).

Regarding claims 5, 9 and 10, Gotomyo is silent with regards to specific product density, therefore, it would have been necessary and thus obvious to look to the prior art for conventional product density. Greaves and Hoshino provide this conventional teaching showing that it is known in the glass wool art to use a density of 8-80 kg/m<sup>3</sup> or 100-230 kg/m<sup>3</sup>, respectively (paragraph bridging columns 1 and 2 of Greaves and computer translation Detailed Description

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paragraph [0006] of Hoshino). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the product density 8-80 kg/m<sup>3</sup> or 100-230 kg/m<sup>3</sup>, motivated by the expectation of successfully practicing the invention of Gotomyo.

7. Claims 4, 7, 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,381,330 to Gotomyo in view of any one of USPN 5,665,447 to Greaves or JP 07-096563 to Hoshino as applied to claims 1-3, 5, 9 and 10 above, and further in view of USPN 2,444,347 to Greger.

Gotomyo does not appear to mention a hardened layer formed on at least one surface of the product, but Greger discloses that it is known in the glass wool art to apply a hardened layer of an inorganic adhesive agent (aluminum phosphate) on at least one surface of a glass wool product (see entire document including column 1, lines 40-47 and column 4, lines 30-59). It would have been obvious to one having ordinary skill in the art at the time the invention was made to form a hardened layer on at least one surface of the product, motivated by a desire to remove or reduce brashness of the product surface.

Gotomyo appears to teach a hexahedron shape (Figures 1 and 2). In addition, Greger discloses that it is known in the glass wool product art that the construct the product with one of various shapes (column 4, lines 46-49). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the product in any suitable shape, such as a hexahedron, because it is within the general skill of a worker in the art to select a known shape on the basis of its suitability and desired characteristics.

Regarding claim 11, Gotomyo is silent with regards to specific product density, therefore, it would have been necessary and thus obvious to look to the prior art for conventional product density. Greaves and Hoshino provide this conventional teaching showing that it is known in the glass wool art to use a density of 8-80 kg/m<sup>3</sup> or 100-230 kg/m<sup>3</sup>, respectively (paragraph bridging columns 1 and 2 of Greaves and computer translation Detailed Description paragraph [0006] of Hoshino). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the product density 8-80 kg/m<sup>3</sup> or 100-230 kg/m<sup>3</sup>, motivated by the expectation of successfully practicing the invention of Gotomyo.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew T Piziali/

Primary Examiner, Art Unit 1794